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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/781,592 | 02/12/2001 | Beverly M. Emerson | 1211.003US1 | 1304 |
| 54244 | 7590 | 10/18/2006 | EXAMINER | |
| KLARQUIST SPARKMAN, LLP 121 S.W. SALMON STREET SUITE 1600 PORTLAND, OR 97204 | | | MARVICH, MARIA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1633 | |

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/781,592

Applicant(s)

EMERSON, BEVERLY M.

Examiner

Maria B. Marvich, PhD

Art Unit

1633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 38,40,54-56,63,64,66,72,74,80-85,88 and 100-105.
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

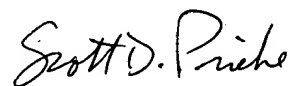
Continuation of 3. NOTE: Applicants' proposed amendment to claim 74 as well as the addition of claim 106 change the scope of the claims from a method utilizing a SWI/SNF chromatin remodeling complex to identify compounds to a method in which a minimal SWI/SNF complex is utilized. This minimal complex is said to be BRG1 and BAF155. This amendment requires new search and consideration of art for example obviousness issues regarding use of a minimal complex in combination with Armstrong et al.

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claims 63, 64, 66, 68, 74, and 106 under the judicially created doctrine of obviousness type double-patenting is dropped due to the abandonment of application 10/763672.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants have traversed the rejection under 35 USC 102(b) as being anticipated by Armstrong et al based upon the argument that "a zinc-finger DNA binding domain peptide" does not mean the protein or any other part of the protein except the zinc-finger domain. Applicants point to support for this stance in the specification by its teachings that use of the entire protein can be problematic (page 29, line 27- page 30, line 4) as well as various other passages that are said to teach that the zinc-finger domain peptide is not full-length. Furthermore, applicants argue that the plain meaning of this term suggests that applicants intended on use of only the zinc-finger domain.

Applicants' arguments have been considered but are not persuasive. In fact, the broadest interpretation of the term "a zinc-finger DNA binding domain peptide" is not exclusively limited to the zinc-finger domain. Rather, and as supported by the specification, applicants invention is meant to encompass methods in which full-length peptide is used to identify compounds (see e.g. Example 1 in which full-length peptide is used in vitro to interact with SWI/SNF). Furthermore, neither the specification nor the prior art define "a zinc-finger DNA binding domain peptide" to simply the zinc-finger domain. The term "a zinc-finger DNA binding domain peptide" describes peptides that comprise zinc-finger domains and these peptides include transcription factors such as EKLF. A peptide is not size limited to small proteins but simply is a polypeptide and as such any peptide comprising a zinc-finger domain will meet the definition of "a zinc-finger DNA binding domain peptide".

Continuation of 13. Other: Had the amendment been entered, applicants reply would have overcome the rejection of claims 38, 40, 54-56, 63, 64, 66, 72, 74, 80-85, 88 and 100-105 under 35 USC 112, first paragraph for New Matter.



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PRIMARY EXAMINER